REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 8, 9, 16, 17, 24, 28, 30, 36, 42, 43, 44 and 45 have been amended. Claims 46-51 have been added. Claims 1, 2, 5-10, 13-18 and 21-51 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims. For example, new dependent claims 46-51 add limitations that have already been subject to a previous action on the merits. No new matter has been added.

35 U.S.C. § 112

The Office Action rejected claim 28 under 35 U.S.C. § 112, second paragraph. Applicant has made an earnest attempt to amend claim 28 in a manner that overcomes such rejection.

35 U.S.C. § 103(a)

In the Office Action mailed January 12, 2006, claims 1 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,096 ("Kuppusamy").

As amended, claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;
> at a first location within the electronic version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause an operation associated with the second location.

As amended, claim 43 recites:

> 43. A method performed by a computer system, comprising:
> storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;
> at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location; and
> in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device.

MPEP § 2142 states, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to amended claims 1 and 43, Kuppusamy is defective in establishing a prima facie conclusion of obviousness. For example, as between Kuppusamy and Applicant's specification, only Applicant's specification teaches the combinations of elements in amended claims 1 and 43. In fact, Kuppusamy teaches away from such combinations.

In citing Kuppusamy, the Office Action states, a "heading is detected within the first location of the quarterly report" (emphasis added). Further, the Office Action states, a "hyperlink entry is created in the TOC document for each selected heading" (emphasis added).

As shown in Kuppusamy's Fig. 3, the target document 202 ("quarterly report," where the heading is detected) and the TOC document 220 (where the hyperlink is created) are independent windows, with each window simultaneously displaying a different document. This fact is explicitly taught in Kuppusamy at col. 6, line 63–col. 7, line 1, which states: (a) "a frameset

218" contains "the target document 202 and the TOC document 220"; and (b) "the term 'frameset' relates to the creation of two or more independent windows with each window simultaneously displaying a different document" (emphasis added).

Consequently, Kuppusamy teaches that: (a) the heading is detected in a first document (i.e., the target document 202, which is displayed in a first window), yet the hyperlink is created in a second document (i.e., the TOC document 220, which is displayed in a second window); and (b) the first and second windows are independent.

By comparison, claim 1 includes the following limitations: (a) "at a first location within the electronic version, detecting a reference to a second location"; and (b) "in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause an operation associated with the second location" (emphasis added). Thus, Kuppusamy is contrary to claim 1.

Also, claim 43 includes the following limitations: (a) "at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location"; and (b) "in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device" (emphasis added). Thus, Kuppusamy is contrary to claim 43.

Clearly, therefore, Kuppusamy fails to teach amended claim 1, and in fact teaches away from it. Likewise, Kuppusamy fails to teach amended claim 43, and in fact teaches away from it. Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification.

Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of amended claims 1 and 43 is not supported. Likewise, a rejection of amended claims 9, 17, 44 and 45 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9, 17, 43, 44 and 45.

Dependent claims 2, 5-8, 25-30, 46 and 47 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10, 13-16, 31-36, 48 and 49 depend from and further limit claim 9 and therefore are allowable.

Dependent claims 18, 21-24, 37-42, 50 and 51 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 5-10, 13-18 and 21-51 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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